

## REMARKS

The Examiner is thanked for reconsidering the prior rejection and indicating that claims 9-18 and 29-31 are allowed. As there are new rejections in Paper No. 6, please consider the following remarks.

### ***§112, second paragraph***

Claims 1-5 were rejected as being indefinite. In particular, the Office Action states, “claim 1 does not point out and claim the purpose or use of the invention.” Paper 6, page 2. However, the portion of the statute cited in the Office Action does not require claiming the purpose or use of the invention. Furthermore, a statement of purpose or intended use is not required in a claim’s preamble. See M.P.E.P. §2111.02. Where such a statement is included in the preamble, the purpose or use is not necessarily considered a claim limitation and may have no bearing on claim construction. *Id.* As no basis can be found for requiring that the purpose or use of the invention be claimed, reconsideration of the rejection is respectfully requested.

### ***102(e)—Asselin***

Claims 6 and 7 were rejected as being anticipated by Asselin. Claim 6 is a method of installing a device driver for a newly-installed hardware device in a system. As amended, claim 6 makes clear that the hardware device is a newly-installed hardware device. In contrast, the method of Asselin is for replacing a device driver. 4:18-21. In other words, an original driver is connected to a physical device at the start of Asselin’s method. 4:39-42. The original driver is disconnected from the device during replacement. 4:48-5:3. Clearly, the device is not being newly installed in Asselin. Because Asselin fails to disclose a method for installing a device driver for a newly-installed hardware device, Asselin does not anticipate claim 6 or claims dependent thereon.

### ***102(b)—Merkin***

Claims 26-27 were rejected as being anticipated by Merkin. Claim 26 is an apparatus claim, the apparatus comprising an operating system including a plurality of interfaces to equipment of a corresponding plurality of types, one of which is the first predetermined type, and including a driver ID demander, and a wizard including a common driver which, when identified to the driver ID demander satisfies the driver ID demander’s requirement to identify one of the

plurality of interfaces. It is respectfully submitted that Merkin fails to disclose every element of claim 26.

For example, in Merkin user selection of a target drive does not teach or suggest a driver ID demander. The target drive of Merkin is where a particular device driver is to be installed. 1:25-51; 6:64-7:3 (The help text displayed...will be provided by the author of the installation data profile. Through such help text the developers of the device driver may provide explanation of the options presented such as...reasons for installation of a device driver on a particular drive.); 7:4-27 (Among such options might be selection of a target drive or selection of a path and drive for the device driver...Upon selection of a target drive or target path...installation of the device driver will continue...Such installation will include copying of the device driver into the appropriate path...); 8:43-58 (The default target drive will be either the current computers' first hard drive, first removable media drive if there is no hard drive...). Thus, by selecting a target drive such as a hard disk drive, the user is not identifying a device driver to a driver ID demander.

Additionally, the device driver program discussed in Merkin is not a common driver as claimed. In particular, Merkin explains that each device has a driver and the device driver is a program. 1:25-34; 4:56-59. Furthermore, developers of I/O devices deliver a device driver program on a floppy disk with the I/O device. 1:41-46; 5:51-54. Merkin's installation program reads particular files that are supplied by the developers of the device drivers. 4:66-5:13. Thus, the driver program discussed in Merkin is for a specific device, to be installed via Merkin's installation program

The rejection fails for yet another reason. For argument only, if the device driver program were to be considered a common driver, which it is not, it is the source therefore not an option when selecting a target drive. In other words, in the Office Action it is alleged that the request for selection of a target drive is the result of a driver ID demander. As the target drive is where the driver program is ultimately installed, it simply makes no sense that the source program is a choice for a target drive. Clearly, for at least the reasons expressed above, Merkin does not anticipate claim 26 or claims dependent thereon.

### ***103(a) rejections***

Independent claims 1 and 19 were rejected as being unpatentable over Merkin in view of Asselin. Claim 1 calls for receiving a request to select one of a plurality of available system elements to be installed, receiving an identification of a first system element which is not of the plurality of available system elements, installing the first system element, deinstalling the first system element, and installing the one of the plurality of available system elements.

In the Office Action it is acknowledged that Merkin does not teach an identification of a first system element which is not of the plurality of available system elements, installing the first system element, and deinstalling the first system element.

Asselin too does not disclose receiving an identification of a first system element which is not of the plurality of available system elements. The argument that an incompatible replacement driver is not of a plurality of available system elements is not convincing. Simply, a replacement driver replaces the original driver; the original device driver is unloaded. 5:1-3. Thus, if anything, the replacement driver is one that is selected to be installed. An incompatible replacement driver merely fails to replace the original driver. In effect, attempting to install an incompatible replacement driver does not result in the installation of a different operational driver. Asselin never contemplated a do-nothing driver that is installed and deinstalled to participate in the installation of a different driver.

Furthermore, there is absolutely no evidence provided in the Office Action pointing to a suggestion or motivation to combine the teachings of Merkin and Asselin. That is, merely pointing to various features of the prior art is insufficient to defeat patentability. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). There must be some motivation, teaching or suggestion in the prior art of the desirability of making the specific combination that was claimed. *Id.* The Office Action states that it would be obvious to combine the teachings of the references because it provides a method to install the correct element that is working for both the system and hardware. It is respectfully submitted that this is an unsupported conclusion apparently based on inappropriate hindsight reasoning.

On a similar analysis, claim 19 and claims dependent thereon are believed to be patentable. Reconsideration of the rejections is respectfully requested.

The application is believed to be in condition for allowance. The Examiner's furtherance toward this end is respectfully requested.

Respectfully submitted,

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Rhonda L. Sheldon, Reg. No. 50,457  
TROP, PRUNER & HU, P.C.  
8554 Katy Freeway, Suite 100  
Houston, Texas 77024  
(713) 468-8880 [Phone]  
(713) 468-8883 [Fax]

Customer No.: 21906